

### **REMARKS/ARGUMENTS**

The Applicant originally submitted Claims 1-20 in the application. In a previous response, the Applicant canceled Claims 5, 12, and 19 without prejudice or disclaimer. In the present response, the Applicant not amended, canceled, or added any claims. Accordingly, Claims 1-4, 6-11, 13-18, and 20 are currently pending in the application.

#### **I. Rejection of Claims 1-4, 8-11, and 15-18 under 35 U.S.C. §103**

The Examiner has rejected Claims 1-4, 8-11, and 15-18 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,689,516 to Mack, *et al.* (hereinafter “Mack”) and further in view of U.S. Patent No. 5,515,523 to Kalkunte, *et al.* (hereinafter “Kalkunte”) and U.S. Patent No. 7,124,340 to Bos, *et al.* (hereinafter “Bos”). The Applicant respectfully disagrees because the teachings of the references applied by the Examiner are not sufficient to render the claims *prima facie* obvious.

The Examiner recognizes that neither Mack nor Kalkunte explicitly disclose wherein the testing port comprises a direct loopback between input and output pins thereof and cites lines 60-67 of column 7 and lines 55-60 of column 8 of Bos to cure this deficiency of Mack and Kalkunte. Furthermore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Mack and Kalkunte as taught by Bos in order to isolate defects with the circuit by supporting loopback testing. (See Examiner's Action of February 10, 2009, pages 3-4.) The Applicant contends that it would not have been obvious to modify the teaching of Kalkunte as taught by Bos as doing so would change the principle of operation of Kalkunte.

The portions of Kalkunte cited by the Examiner teach memory controller 20 monitors memory transfers requested by bus A interface 30. If a volume of requests indicates that FIFOs contained in bus A interface 30 may be significantly backed up, then memory controller 20 partially disables memory transfers with bus B interface 40. When bus B interface 40 is partially disabled, a predetermined number of requests from bus A interface 30 will be granted before on request (if pending) from bus B interface 40 will be granted. Thus, the cited portions of Kalkunte teach partially disabling a first bus interface while a second bus interface can access a memory array. Modifying this cited portion of Kalkunte with the direct loopback teachings of Bos would change the principle of operation of Kalkunte because looping back would not allow the first bus interface to be disabled and, thus, not allowing the other bus interface to have free access to the memory array. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." (*See In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). *See also* MPEP 2143.01(VI).) Also, "the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose." (*See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). *See also* MPEP 2143.01(V).)

As such, the cited portions of the cited combination of Mack, Kalkunte, and Bos, as applied by the Examiner, do not provide a *prima facie* case of obviousness of independent Claims 1, 8, and 15 and Claims that depend thereon. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §103(a) rejection of Claims 1-4, 8-11, and 15-18 and allow issuance thereof.

## **II. Rejection of Claims 7, 14, and 20 under 35 U.S.C. §103**

The Examiner has rejected Claims 7, 14, and 20 under 35 U.S.C. §103(a) as being unpatentable over Mack and further in view of Kalkunte, Bos, and U.S. Patent No. 6,522,100 to Hansford (hereinafter "Hansford"). As established above, the cited combination of the portions of Mack, Kalkunte, and Bos does not provide a *prima facie* case of obviousness of independent Claims 1, 8, and 15. Hansford has not been cited to cure the above-noted deficiency of the cited combination but to teach wherein the IC is a baseband chip of a mobile communication device. (See Examiner's Action of February 10, 2009, pages 5-6.) As such, the cited combination of the cited portions of Mack, Kalkunte, Bos, and Hansford does not establish a *prima facie* case of obviousness of independent Claims 1, 8, and 15 and Claims that depend thereon. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §103(a) rejection of Claims 7, 14, and 20 and allow issuance thereof.

### **III. Conclusion**

In view of the foregoing remarks, the Applicant now sees all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicits a Notice of Allowance for Claims 1-4, 6-11, 13-18, and 20.

The Applicant requests the Examiner to telephone the undersigned agent of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

**HITT GAINES, PC**

A handwritten signature in black ink, appearing to read "Steven J. Hanke". The signature is fluid and cursive, with the first name "Steven" and last name "Hanke" clearly distinguishable.

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Dated: May 11, 2009

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